

## **REMARKS**

### **Claim Rejections**

Claims 34, 38 and 43-44 are rejected under 35 U.S.C. §112, second paragraph. Claims 31-34, 38-39, 42 and 46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kaneko et al. (U.S. 6,441,524) in view of Tajima et al. (U.S. 5,811,904). Claims 31-34, 36, 39, 41-42 and 46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tanimoto et al. (JP-4-05176487) in view of Tajima et al. (U.S. 5,811,904). Claims 31-34, 36, 38-40 and 42-46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Futami et al. (JP-4-05191936) in view of Tajima et al. (U.S. 5,811,904). Claim 37 is rejected under 35 U.S.C. §103(a) as being unpatentable over one of the combination of applied references in sections 2-4 of the outstanding Office Action, and further in view of Elliott et al. (U.S. 5,992,003). Claim 35 is rejected under 35 U.S.C. §103(a) as being unpatentable over one of the combination of applied references in sections 2-4 of the outstanding Office Action, and further in view of Johnson et al. (U.S. 5,801,470).

### **Drawings**

The Examiner has objected to the drawings under 37 C.F.R. § 1.83(a) insofar as the subject matter of claim 37 was not illustrated in the figures. Since claim 37 has been deleted from Applicant's claims, it is not believed that any drawing corrections are necessary.

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, except as discussed above, Applicant must assume that the drawings are acceptable as filed.

### **New Claims**

By this Amendment, Applicant has canceled claims 31, 35, 37, 41 and 44-46, amended claims 32-34, 36, 38-40 and 42-43, and added new claims 47-50 to this application. It is believed that the amended and new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and

define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

Claims 38 and 43 have been rewritten in independent form to obviate the outstanding rejections under 35 U.S.C. § 112. Claims 32-34, 36 and 42 all depend from amended independent claim 38. Claims 39, 40, and 47-50 all depend from amended independent claim 43. New claims 47-50 are commensurate in scope with amended claims 32-34 and 36.

The primary reference to Kaneko et al. discloses a rotor for a synchronous motor including a rotor (51) including a core (17), and a plurality of V-shaped magnets (15) inserted into the core.

Kaneko et al. do not teach the two side surfaces in each of the plurality of openings are each parallel with an outer contour of the cylindrically shaped rotor core; nor do Kaneko et al. teach a channel having a predetermined width is located between two parallel channel side surfaces.

The secondary reference to Tajima et al. discloses a permanent magnet dynamo electric machine including a stator (20), a rotor (30) having a plurality of permanent magnet insertion hole (34), and a plurality of permanent magnets (36) inserted into the insertion holes.

Tajima et al. do not teach the two surfaces in each of the plurality of openings are each parallel with an outer contour of the cylindrically shaped rotor core; nor do Tajima et al. teach a channel having a predetermined width is located between two parallel channel side surfaces.

The secondary primary reference to Tanimoto et al. discloses a permanent magnet type motor including a rotor core (2), permanent magnets (6-9), and a stator.

Tanimoto et al. do not teach the two side surfaces in each of the plurality of openings are each parallel with an outer contour of the cylindrically shaped rotor core; nor do Tanimoto et al. teach a channel having a predetermined width is located between two parallel channel side surfaces.

The secondary reference to Futami et al. discloses a permanent magnet type rotor including a permanent magnet inserting opening part (1), a peripheral ring part (7), a yoke part (8), and a joint (9).

Futami et al. do not teach the two side surfaces in each of the plurality of openings are each parallel with an outer contour of the cylindrically shaped rotor core; nor do Futami et al. teach a channel having a predetermined width is located between two parallel channel side surfaces.

Even if the teachings of Kaneko et al. , Tajima et al., Tanimoto et al. and Futami et al. were combined, as suggested by the Examiner, the resultant combination does not suggest the two side surfaces in each of the plurality of openings are each parallel with an outer contour of the cylindrically shaped rotor core; nor does the combination suggest a channel having a predetermined width is located between two parallel channel side surfaces.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Kaneko et al., Tajima et al., Tanimoto et al., nor Futami et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Serial No. 10/036,504

Neither Kaneko et al., Tajima et al., Tanimoto et al., nor Futami et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's amended and new claims.

**Summary**

In view of the foregoing, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should the Examiner not be of the opinion that this case is in condition for allowance, it is requested that this amendment be entered for the purposes of appeal, since it materially reduces the issues on appeal by cancelling claims 31, 35, 37, 41 and 44-46, thereby rendering moot the outstanding rejection of this claim under 35 U.S.C. § 103.

It is not believed that the new claims 47-50 require any further searching and/or consideration on the part of the Examiner, since the new claims are commensurate in scope with amended claims 32-34 and 36. Thus, the Examiner would have inherently searched the subject matter during the previous consideration of claims 32-34 and 36.

Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: April 5, 2004

By:

  
Bruce H. Troxell  
Reg. No. 26,592

TROXELL LAW OFFICE PLLC  
5205 Louisbourg Pike, Suite 1404  
Falls Church, Virginia 22041  
Telephone: 703 575-2711  
Telefax: 703 575-2707